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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,785	09/15/2003	Ulrich Ensslin	095309.52768US	7264

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EXAMINER

EDMONDSON, LYNNE RENEE

ART UNIT PAPER NUMBER

1725

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,785

Applicant(s)

ENSSLIN ET AL.

Examiner

Lynne Edmondson

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 5-17 and 25-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 5-17 and 25-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/12/05.

It is noted that the claims have not been canceled.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Siemens AG (DE 2129918 B, IDS).

Siemens teaches a method for installing temperature sensitive electronic components on a board by providing a board with openings through which an electronic component passes, providing a removable protection apparatus to protect the

component during soldering, connecting the component and removing the protection apparatus after soldering is completed (abstract and figures 1-6).

4. Claims 1-4 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hotze (USPN 3723943,IDS).

Hotze teaches a method for installing temperature sensitive electronic components on a board by providing a board with openings through which an electronic component passes, providing a removable protection apparatus to protect the component during soldering, connecting the component and removing the protection apparatus after soldering is completed (figure 1, col 1 lines 30-47 and col 4 line 35 – col 5 line 38).

5. Claims 1-4 and 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Chung (USPN 6267288 B1).

Chung teaches a method for installing temperature sensitive electronic components on a board by providing a board with openings through which an electronic component passes, providing a removable protection apparatus to protect the component during soldering, connecting the component and removing the protection apparatus after soldering is completed. Both wave and reflow soldering are taught (figures 1C, 2A-2C and col 4 lines 1-49).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLellan et al. (USPN 5913552, IDS) in view of Woychik et al. (USPN 5644475).

McLellan teaches a method for installing temperature sensitive electronic components on a board by providing a board to which an electronic component is attached, providing a removable protection apparatus comprising a plastic bubble (cap 9) with a metal coating to protect the component during soldering, connecting the component and removing the protection apparatus after soldering is completed (figure 1, col 4 lines 9-57 and col 5 lines 18-32). As shown in figure 1 the components are embedded in the board but do not protrude completely through the board. There is no disclosure of through hole components.

Woychik teaches surface mounting and through hole mounting as obvious variations and uses the same type of protection apparatus for both col 6 lines 41-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention that surface mount reflow and wave solder are obvious variations.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Price et al. (EPN 0750325 A1, plastic bubble, metal coating, IDS), Brown et al. (USPN 4216051, wave and reflow), Thompson, Sr. (USPN 6145729), Howell (USPN 6142357), Nakatsuka et al. (USPN 6585149) and Streckfuss et al. (USPN 6145733).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (571) 272-1172. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Lynne Edmondson
Primary Examiner
Art Unit 1725

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12/13/05

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